

REMARKS/ARGUMENTS

The Pending Claims

Claims 17-22, 25-29, 38, 39, and 41-64 currently are pending.

The Restriction Requirement

The Office has required restriction between the following groups of claims:

Group I: Claims 51-53 and 58-60, drawn to a method for immunizing or inducing an immune response in an animal with a nucleic acid encoding at least one attenuating mutation in Kunjin virus non-structural protein; and

Group II: Claims 54-57 and 61-64, drawn to a method for immunizing or inducing an immune response in an animal with a nucleic acid encoding at least one attenuating mutation in Kunjin virus structural protein.

The Office has indicated that claims 17-22, 25-29, 38, 39, and 41-50 are generic linking claims that link the claims of Group I and Group II. In addition, the Office has required Applicants to elect a single attenuating mutation with respect to the claims of Group I or Group II for further prosecution.

Applicants' Election

In response to the restriction requirement, Applicants elect, with traverse, the invention of Group I (i.e., claims 51-53 and 58-60) drawn to a method for immunizing or inducing an immune response in an animal with a nucleic acid encoding at least one attenuating mutation in Kunjin virus non-structural protein, for further prosecution. Applicants note that, in accordance with M.P.E.P. § 809, the linking claims (i.e., claims 17-22, 25-29, 38, 39, and 41-50) must be examined with, and thus are considered part of, the elected invention.

With respect to the required species election, Applicants elect species (1) as recited in the Office Action, namely proline residue 250 of nonstructural protein NS1. Claims 17-22, 25-29, 38, 39, 41-53, and 58-60 are generic to (i.e., encompass) the elected species.

While Applicants have provided an election for the aforementioned specific species, the specific species election merely is intended to aid the Examiner in the search and examination of the present patent application. The election is by no means indicative of Applicants' willingness to ultimately limit the invention to this species. Applicants understand that, consistent with an election of species requirement, other species will be considered within the "generic" claims encompassing the elected species upon an indication of allowable subject matter with respect to the elected species.

In addition, Applicants reserve the right to pursue any non-elected subject matter that is ultimately canceled in the present application in one or more divisional applications in accordance with U.S. patent practice.

Discussion of the Restriction Requirement

The subject application is a U.S. national stage application based on International Patent Application PCT/AU2004/001505. The Office alleges that the inventions defined by the claims of Groups I and II do not relate to a single inventive concept under PCT Rule 13.1 because they lack the same or corresponding "special technical features." Under PCT Rule 13.2, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. PCT Rule 13.2 defines the term "special technical features" as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art (see M.P.E.P. § 1893.03(d)).

The Office contends that the technical feature that links Groups I and II is a method for immunizing an animal with a nucleic acid encoding at least one attenuating mutation in a Kunjin virus non-structural or structural protein. However, the Office alleges that a method of immunizing an animal by administering a nucleic acid encoding an attenuated Kunjin virus genome comprising nucleic acids encoding foreign heterologous epitopes has been disclosed by Anraku et al., *Journal of Virology*, 76: 3791-3799 (2002), such that this feature is not inventive and cannot serve as a single inventive concept. Applicants respectfully disagree and traverse.

The claims of Groups I and II are linked so as to form a single general inventive concept. In other words, the claims of Groups I and II share a common special technical feature, which defines a contribution that each claim makes over the prior art. In this respect, the claims of Group I are directed to a method comprising administering an isolated nucleic acid encoding an *infectious attenuated* Kunjin virus to an animal, wherein the isolated nucleic acid encodes at least one attenuating mutation in a Kunjin virus non-structural protein. The claims of Group II are directed to a method comprising administering an isolated nucleic acid encoding an *infectious attenuated* Kunjin virus to an animal, wherein the isolated nucleic acid encodes at least one attenuating mutation in a Kunjin virus structural protein. Accordingly, all of the claims of Groups I and II are directed to a method comprising administering an isolated nucleic acid encoding an *infectious attenuated* Kunjin virus to an animal.

As set forth in more detail in the “Reply to Office Action” dated September 15, 2008, Anraku et al. does not disclose or suggest the use of an isolated nucleic acid capable of producing an infectious virus, much less an infectious attenuated Kunjin virus, as required by the claims of Groups I and II. Given the special technical feature common to the claims of Groups I and II, a search for prior art with respect to any of Groups I and II would likely uncover references that would be considered by the Office during the examination of the other groups. Moreover, Applicants note that the Office previously has searched and examined a method comprising administering an isolated nucleic acid encoding an infectious attenuated Kunjin virus to an animal, wherein the isolated nucleic acid encodes at least one attenuating mutation (see, e.g., pending claim 19). As a result, the Office would incur no undue burden in examining the claims of Groups I and II at the same time. See also M.P.E.P. § 803 (“If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” (emphasis added)).

In view of the foregoing, Applicants request withdrawal of the requirement for restriction between the claims of Groups I and II, and respectfully submit that the claims of Groups I and II should be examined together.


If, however, the restriction requirement is not withdrawn, Applicants note that, as set forth in MPEP § 809, when all claims directed to the elected invention, along with any

linking claims are allowable, the restriction requirement between the linked inventions must be withdrawn. Any claims directed to the non-elected inventions, which depend from or require all the limitations of the allowable linking claim must be rejoined and be fully examined for patentability. Applicants therefore request, upon a finding that any of claims 17-22, 25-29, 38, 39, and 41-50 are in condition for allowance, that the restriction requirement as to Groups I and II be withdrawn and that any withdrawn claims be rejoined and examined.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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